

REMARKS / ARGUMENTS

Applicants respectfully request reconsideration of the above-identified application. This amendment is being filed together with a Supplemental Declaration under 37 C.F.R. §1.132 and a Request for Continuing Examination.

With the present amendment and response, claim 1 has been amended with the addition of the language "wherein damage to said structural automobile part is decreased during shipping" to the preamble and to step (c). This amendment makes express what is an inherent feature of the claimed invention, namely the prevention of damage to the structural automobile part during shipment. Accordingly, Applicants assert that no claims have been narrowed with the meaning of *Festo* (*Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 US 722, 112 S.Ct. 1831, 152 L.Ed.2d 944, 62 USPQ2d 1705 (2002)). See also *Interactive Pictures Corp. v. Infinite Pictures Inc.*, 274 F.3d 1371, 61 USPQ 1152 (Fed. Cir. 2001) (addition of the words "transform calculation" was not a narrowing amendment because that addition did nothing more than make express what had been implicit in the claim as originally worded).

New claim 24 has been added which recites that the damage prevented by the packaging and shipping method of claim 1 comprises one or more of scratching, denting, breaking, abrading, and stressing. See, present application at page 4.

Applicants' undersigned attorney telephoned the Examiner on January 5, 2005 to request that the Examiner grant Applicants an interview prior to issuing the Examiner's next Office action. The Examiner indicated that he would make a note in the file to contact the undersigned at that time. Despite Applicants' request, the Examiner issued a final Office action on March 4, 2005. Having been denied the requested interview, Applicants respectfully request that the Examiner withdraw the finality of the Office action and consider the attached declaration, which sets forth the information that would have been presented at the proposed interview. In the alternative, Applicants request that the Examiner enter the enclosed Request for Continuing Examination.

Claim 1 stands rejected under 35 U.S.C. § 102 as being anticipated by Meyer, U.S. Patent No. 3,784,004 (Meyer). As amended, Claim 1 is neither anticipated nor rendered obvious by Meyer, either alone or in combination with any of the cited references. First, Meyer does not disclose a method for packaging and shipping a structural automobile part wherein damage to said structural automobile part is decreased. As such, Meyer does not disclose each and every feature of the claimed invention and cannot anticipate it. Second, claim 1 is not obvious in view of Meyer.

Meyer's invention resides in a completely different field than that of the present invention and addresses a completely different problem. As such, Meyer is non-analogous art and cannot render the claimed invention obvious.

Claim 1 has been amended to recite that "damage to said structural automobile part is decreased during shipping." In developing the present invention, Applicants faced the problem of packaging and shipping structural automobile parts without damage caused by unwanted tactile contact. Such unwanted contact may be an impact, for example, when a part is dropped. Tactile contact also may occur when heavy objects are placed on top of the packaged part, leading to bowing or other deformation. Unwanted tactile contact causes two categories of damage during shipment. Certain parts, such as windshields, are susceptible to breakage. Other parts, such as fenders, hoods, doors, etc., are not likely to break but may be dented, scratched or otherwise abraded. Another problem associated with shipping all structural automobile parts is their relatively large size, awkward shape, and heavy weight. These problems are set forth at page 4 of the present application, which states that:

Of similar importance is the prevention of the object being shipped from moving, shifting, or otherwise changing position during loading, shipping, and storage of the object. Smaller objects, even delicate and breakable objects, are easier to pack for shipment because of their small size. When the object is large and heavy, such as an automobile structural part, proper packing for its safe shipment is anything but routine. Even "unbreakable" structural automobile parts, such as hoods, fenders, and doors, can become scratched, dented, and abraded to the point that rework of the part is needed. When the structural automobile parts are breakable and non-planar, such as automobile windshield glass, the packing problems become even more compounded. Now, the packer must be attentive to scratching, abrading, breaking, and stress, of a part that can weigh upwards to several hundred pounds. A daunting task for the part manufacturer and shipper indeed.

Applicants' invention contemplates a single packaging method that addresses all of these problems. This is true regardless of whether the structural automobile part is a windshield or it is a fender, door or hood. This also is true regardless of whether the damage is breakage, denting, scratching, etc. See, Present Application at page 7.

Nowhere does Meyer disclose the packaging of a structural automobile part "wherein damage to said structural automobile part is prevented during shipping." This is not surprising as Meyer's invention is directed to packaging "to prevent entry and exit of moisture through the substrate into the chamber in which the article is encased." Col. 1, lines 7-9. This is stated over and over again throughout the patent. It is Meyer's only

concern, and it is a storage rather than a shipping concern. See Col. 1, lines 18-20 ("to prevent entry of air or moisture through the substrate into the chamber in which the article is encased"); Col. 1, lines 26-28 ("which prevents passage of moisture and air into and out of the chamber through said substrate so as to substantially hermetically seal said article in the chamber"); Col. 2, lines 22-28 (For instance, it would be desirable to achieve prevention of moisture entry into the chamber having the encased article so as to prevent or minimize corrosion effects on the article or to prevent escape of moisture where bakery goods are packaged so as to eliminate staleness and dehydration of the goods."); Col. 2, lines 50-55 ("The portion of the substrate contacted by and below the article remains non-porous by reason of the unmelted coating forming a vapor protection barrier which prevents passage of air into the chamber having the article encased therein."); Col. 2, line 66 to Col. 3, line 5 ("The invention also provides a novel skin package having a barrier protection coating on the otherwise porous substrate subtending the article encased in a vacuum-formed plastic film chamber which prevents passage of air or moisture through the otherwise porous substrate subtending said article and relative to said chamber."); Col. 4, lines 36-39 ("In this manner, the substrate having coating 20A remains non-porous and thereby hermetically seals the mouth 23 to chamber 18 with the article 14 therein."); Col. 4, lines 57-61 ("The coating material selected has the property of remaining solid at ordinary room temperatures so that it can function as a moisture-barrier protective coating on an otherwise porous substrate or base pad."); Col. 5, lines 39-49 ("When packaging metal products such as bearings, clutches, or various automobile or mechanical parts, the barrier coating 20A provides corrosion protection by preventing moisture entering the chamber 18. It is contemplated that corrosion-inhibiting products can be added to the chamber 18 to obtain a long-lasting anti-corrosion package. The barrier coating 20A in cooperation with the substrate 12 supporting same closes the mouth 23 to the chamber 18 to prevent moisture or air from entering the chamber."); and Col. 5, lines 60-64 ("Actual tests of the skin package embodying the invention... have enabled frozen meat or poultry to be skin packaged for four to six weeks without dehydration.").

Along those same lines, Meyer also does not disclose a "Method for packaging an automobile part to decrease damage during shipment." Present application, Claim 1. Generally, the preamble does not limit a claim. However, where the preamble gives "life, meaning and vitality" to the claims, it is appropriate to consider the preamble in determining patentability. The fact that claim 1 is directed to packaging for shipment is

extremely important. It defines the what capabilities the packaging must have. For example, the requirements for decorative packaging, like gift wrapping, are not the same as for storage packaging. Likewise, the packaging requirements for storage are not the same as for shipping. The amendment to step (c) further stresses this point. The packaging must be able to prevent damage during shipment.

Meyer does not disclose a method for packaging an automobile part for shipment. Neither the word "ship" nor "shipping" appear anywhere in Meyer. Meyer is strictly directed to packaging for storage. There is no teaching or suggestion that Meyer's packaging would be capable of protecting its article from damage of the type described above, e.g., breaking, denting, scratching, etc. The words damage, break, dent, abrade also do not appear anywhere in Meyer. In order to anticipate a claim, a reference must include each and every claim limitation. Meyer clearly does not anticipate the claimed invention because it does not include the above-described damage prevention feature of the invention.

Claim 1 also is not obvious in view of Meyer. Meyer is non-analogous art and, therefore, the skilled artisan would not look to it when confronted with the present problem. To determine whether a reference is analogous art, one must consider whether 1) the reference is within the field of the inventor's endeavor and 2) the reference is reasonably pertinent to the particular problem with which the inventor was involved. Neither of these is true with respect to Meyer and the present invention.

As indicated in his original declaration, Mr. Youell has been involved in the manufacture and design of corrugated packaging for 45 years. Declaration under 37 C.F.R. § 1.132, ¶ 2. He was a principal in the formation of two successful packaging companies. Declaration under 37 C.F.R. § 1.132, ¶ 5. He also is an inventor on two patents addressed to inventions in the packaging field. Declaration under 37 C.F.R. § 1.132, ¶¶ 3 and 4. Submitted herewith is a subsequent declaration of Donald R. Youell, Jr., which further addresses the inapplicability of Meyer as non-analogous art.

First, Meyer is not within the field of the inventor's endeavor. Meyer is in the field of article preservation. He is concerned with preventing the degradation of articles, primarily food, caused by the passage of air or moisture through a conventional porous substrate. Supplemental Declaration under 37 C.F.R. § 1.132, ¶ 2. On the other hand, the present invention is in the field of structural automobile shipment. *Id.* at 6.

Second, Meyer is not reasonably pertinent to the particular problem with which the inventor is involved. As noted above, Meyer poses the problem of making a skin

packaging utilizing a conventional porous substrate impervious to the passage of air or moisture therethrough. *Id.* Meyer identifies that, where the packaged article is food, passage of air and moisture from the packaging may cause damage in the form of staleness or dehydration. *Id.* at ¶ 3. Exposure of a packaged article to air and moisture may cause damage in the form of corrosion *Id.* at ¶ 4. Meyer solved these problems by applying one or more coatings, such as a low melting point barrier coating, to the porous substrate in order to prevent air or moisture from escaping or entering the packaging. *Id.* at ¶ 5.

Applicants, on the other hand, faced the problem of reducing physical damage to structural automobile parts caused by the unwanted tactile contact, such as an impact, of an object against the structural automobile part during shipping. *Id.* at ¶ 6. Unwanted tactile impact to structural automobile parts formed primarily of glass, such as windshields, causes physical damage in the form of breakage. *Id.* at 7. For structural automobile parts formed of metal, such as hoods and fenders, unwanted tactile impact causes physical damage in the form of scratching and/or denting. *Id.* at ¶ 8. There is no teaching or suggestion that the packaging disclosed in Meyer could protect windshields from breaking, fenders from denting, or hoods from scratching. With respect to metal parts, specifically "barings, clutches, or various automobile or mechanical parts," Meyer teaches only how to package such parts to prevent corrosion. See Col. 5, lines 39-49. Further, it is error to define the problem in terms of its solution. To do so is improper hindsight. Stated another way, just because the final solutions are similar does not mean that the problems were the same. Meyer simply is not reasonably pertinent to the problem faced by Applicants. Mr. Youell, having over 45 years of experience in the field of packaging and shipping, affirmatively states that the skilled artisan would not look to Meyer or any other reference dealing with the presence or absence of air or moisture to solve the problem of shipping structural automobile parts without damage. *Id.* at 9.

Because it is not reasonably pertinent to Applicants' particular problem and is not in the field of Applicants' endeavor, Meyer is non-analogous art and cannot render the claimed invention obvious.

In the outstanding Office action, the Examiner raises several objections to Mr. Youell's previously submitted declaration. In particular, the Examiner states that no factual evidence has been provided for paragraphs 11, 12, 17 and 18 of the declaration. These paragraphs deal with the decreased breakage rates experienced by Mr. Youell's customers and set forth Mr. Youell's increased sales. Applicants first would note that, in

his declaration, Mr. Youell is attesting under penalty of perjury to what his customers have reported to him on the benefits of the invention. The letters submitted with his declaration were intended merely to provide additional support for his statements. Such letters, maintained by Mr. Youell in the ordinary course of business, are an exception to federal courts' hearsay rule of evidence and are proper support for Mr. Youell's declaration. Mr. Youell also is able to attest based on first hand knowledge as to the increase in sales that his company has experienced as a result of implementation of the inventive method.

Also, although his statements set forth a qualitative rather than quantitative analysis, this does not mean that his statements are not facts. Specific details regarding breakage rates are considered trade secrets in the industry. By providing the information on breakage in terms of percentages, his statements show the improvement realized without disclosing his customers or his sensitive, trade secret information. As such, Applicants request that his statements be fully considered.

A check in the amount of \$930.00 is enclosed for the fees required under 37 C.F.R. § 1.16(i); 1.17(e); and 1.17(a)(3). The Commissioner is hereby authorized to charge any underpayment or credit any excess to Deposit Account No. 13-4830. A duplicate of this sheet is enclosed.

In view of the foregoing remarks, wherein the claim program is seen to readily distinguish over the references, Applicants earnestly solicit issuance of a Notice of Allowance.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on September 6, 2005 with the United States Postal Service as first class mail in an envelope addressed to:

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